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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,089

12/16/2004

Hidekazu Tanigawa

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EXAMINER

ANTONIENKO, DEBRA L

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

09/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,089	Applicant(s) TANIGAWA, HIDEKAZU	
	Examiner DEBRA ANTONIENKO	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/16/2004; 8/22/2005; 7/23/2007; 12/14/2007; 2/14/2008; 8/28/2008.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claims 1 and 6 recite the terms “read-in” and/or “reading-in.” These terms are vague and indefinite. Claims 2-5 and 7-10 are dependent and are rejected in a like manner.

3. Claims 2 and 7 recite “characteristics intrinsic to said specification.” It is vague and indefinite what characteristics are intrinsic to the specification.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory

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classes of invention set forth in 35 U.S.C. 101, i.e. a process, machine, manufacture, or composition of matter.

Regarding Claims 1-5: Claim 1 recites a computer program with steps for reading, analyzing, calculating, and outputting. This is considered to be software per se unless there is an apparatus as well that is capable of executing the software appropriately in order to provide functionality. In other words, for applicant to claim the steps performed by the program, the applicant must recite the claims such that when the program is executed, the program causes a computer/processor to perform the steps. Claims 2-5 are dependent and are rejected in a like manner.

Regarding Claims 6-10: Claim 6 recites a device, however, the "parts" recited appear to be steps of a method or process and not parts of a device or machine. Therefore, similarly, in order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Claims 6-10 are dependent and are rejected in a like manner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Barney et al., U.S. Patent Number 6,556,992 B1 (hereinafter Barney).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claims 1 and 6, Barney teaches a specification analysis step of reading-in a specification and analyzing said specification (column 7, line 61 - column 8, line 18); a patent value calculation step of quantitatively calculating a patent value based on analysis results obtained in said specification analysis step (Figure 11); and a patent value output step of outputting said patent value (column 28, lines 14-37) .

Regarding Claims 2 and 7, Barney further teaches wherein said patent value calculation step calculates a value for each of a plurality of characteristics intrinsic to said specification, and said patent value output step outputs said value for each of said

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plurality of characteristics (column 6, lines 3-57).

Regarding Claims 3 and 8, Barney does not explicitly disclose the term “specification disclosure level,” however, Barney does disclose patent value calculation step calculates (patent metrics) using an amount of description for claims (number of words per claim) and an amount of a portion or entirety of description for preferred embodiments (length of patent specification) as parameters (column 11, lines 38-59; column 12, lines 7-23).

Regarding Claims 4 and 9, Barney does not explicitly disclose the term “inventive feature extraction level” and the patent value calculation step calculates the smallest number of elements composing one claim as a parameter, however, Barney does disclose the use of counting the number of elements in claims and using the “word count” of claims, smallest to largest, to illustrate statistical relationships (column 20, lines 18-28; Figure 4).

Regarding Claims 5 and 10, Barney does not explicitly disclose the term “invention expansion level,” however, Barney does disclose patent value calculation step calculates (patent metrics) using at least one of a number of claims, a depth of claim nesting level, and a number of claim categories as parameters (column 11, lines 38-59).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA
/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689